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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/211,942	12/15/1998	JIM A. LARSON	884.078US1	9145
21186	7590	03/03/2006		
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH 1600 TCF TOWER 121 SOUTH EIGHT STREET MINNEAPOLIS, MN 55402			EXAMINER OSORIO, RICARDO	
			ART UNIT 2673	PAPER NUMBER

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/211,942

Applicant(s)

LARSON ET AL.

Examiner

RICARDO L. OSORIO

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-16, 20, 21 and 23-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-16, 20, 21, and 23-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/29/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

In response to applicant's amendments and arguments in the response filed 9/29/2005, all objections and all rejections under 35 USC 122 are now withdrawn by the examiner.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12-15, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Stevens, III** (5,769,643) in view of **Ohashi** (5,581,783) and **Register et al** (5,606,594).

As to claims 12-15, **Stevens, III** (hereinafter **Stevens**) clearly teaches that a PDA system comprising: a wireless transmitter to transmit electronic voice signals to a PC (see, figs.3 (64,63) and 4; col.3, lines 8-19, lines 35-39); a wireless receiver to receive voice from the PC (see, fig.3 (64,67), col.3, lines 20-22); a touch screen display to enter information in response to physical contact and to visually display the translated voice information (fig.4 (54,56)); col.3, lines 8-22); a stylus having a first end to provide physical contact with the touch screen (fig.4 (55)). **Stevens** also teaches that the PC having a processor (fig.3 (42)); a wireless receiver and transmitter (fig.3 (30)) voice data and the stylus communicating with the PDA (fig.3 (55,62); fig.4 (55,12)).

**Stevens** did not explicitly teach the stylus having a microphone to receive and a transmitter to transmit a voice signal. However, **Ohashi** clearly states that it is well known for a

stylus to have a microphone to receive a voice signal (figs.2, 7 (71)) and a transmitter to transmit the voice signal to the personal computer (same as PDA) (fig.2 (16, 18); col.2, lines 32-53,col.5, lines 38-43). **Ohashi** also teaches that the stylus including a microphone (fig.2 (71)); a switch for the microphone (fig.7 (14), col.6, lines 64- col.7, lines 1) and able to communicate with the personal computer with wire (see, fig.11). It is obvious that the stylus of **Ohashi** has to have a power supply in order to function or to provide the information to the PDA and personal computer.

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to substitute the stylus of Stevens with the that of **Ohashi**'s because this is an advancement for **Stevens**'s stylus in order to capture an image and voice data with the stylus and transferring the information data into the PDA of **Stevens**.

**Stevens** as modified by **Ohashi** did not disclose translating voice data. The patent of **Register et al** is cited to teach that it is conventional for a PDA or computer system to convert voice into electrical signal (see, col.2, lines 61-66, col.3, lines 65-col.4, lines 12).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use the method of converting the voice into electrical signal as taught by **Register et al** the system of **Stevens**, because this is an advantage to the user transmit voice information via the communication link between the stylus and PDA or computer which will allow the PDA to function as part of a voice and a data communication system.

***Response to Arguments***

Applicant argues that the references cannot be combined to teach or make obvious “translating the electronic voice signals into translated voice data and storing the translated voice data in the PDA”.

Examiner disagrees because the patent of **Register et al** is cited to teach that it is conventional for a PDA or computer system to convert voice into electrical signal (see, col.2, lines 61-66, col.3, lines 65-col.4, lines 12).

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to have been motivated to use the method of converting the voice into electrical signal as taught by **Register et al** the system of **Stevens**, because this is an advantage to the user transmit voice information via the communication link between the stylus and PDA or computer which will allow the PDA to function as part of a voice and a data communication system. Also, it is overwhelmingly known in the art of computers or PDAs that a computer or PDA has memory for storing the data in question.

Also, applicant argues that the combination of the references is based on hindsight.

1. Examiner disagrees because it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricardo L. Osorio whose telephone number is 571-272-7676. The examiner can normally be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala whose telephone number is 571-272-7681.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

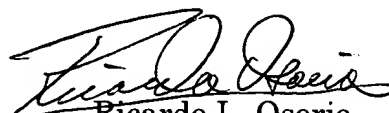
or faxed to: 571-273-8300 (for Technology Center 2600 only)

Hand-delivered responses should be brought to the Customer Service Window at the Randolph Building, 401, Dulany Street, Alexandria, VA 22314.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Ricardo L. Osorio", is positioned above the printed name.

Ricardo L. Osorio  
Primary Examiner  
Art Unit: 2629

RLO

February 21, 2006